

### REMARKS

Favorable reconsideration of this Application in view of the following discussion is respectfully requested.

Claims 2-8, 10-13, 15 and 16 are pending in the present Application. Claims 2, 3, and 16 have been amended to address cosmetic matters of form. This Amendment is submitted in accordance with 37 C.F.R. § 1.116, which permits the entering of Amendments complying with any requirement of form expressly set forth in a previous Office Action or presenting rejected claims in better form for consideration on appeal. As this Amendment does not raise new issues requiring further consideration and/or search, Applicants respectfully request that the present Amendment be entered under 35 C.F.R. § 1.116. No new matter has been added.

By way of summary, the Official Action presents the following issues: Claims 2-8, 10-13, 15, and 16 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter; Claim 16 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite; Claims 2-8, 10-13, 15, and 16 stand rejected under 35 U.S.C. § 102 as being anticipated by Sugiyama (U.S. Patent No. 5,933,625); and Claims 6-8 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sugiyama.

### REJECTION UNDER 35 U.S.C. § 101

The Official Action has rejected Claims 2-8, 10-13, 15, and 16 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants respectfully traverse the rejection.

As outlined in the Applicants' previous response of May 17, 2005, the Official Action is deficient in that it does not present a *prima facie* case that the claimed invention, as a whole, is directed to solely an abstract idea or to manipulation of abstract ideas, or does not produce a useful result. In the previous response, the Applicants requested that if the

rejection of Claims 2-8, 10-13, 15, and 16 were to be maintained under 35 U.S.C. § 101, that the Examiner provide an express statement on the record in accordance with MPEP § 2106 guidelines, which explain how the claims have been interpreted. More specifically, how the claim limitations are deficient to define a practical application in the technological arts of useful, concrete, and tangible results.

A. The Official Action has not satisfied *prima facie* § 101 guidelines.

The Official Action of August 10, 2005 cites a series of case citations and quotations from those case citations, which, while useful in guiding an analysis under 35 U.S.C. § 101, absent factual application of these principles to the **Applicants' claim language**, are merely an aggregation of non-sequitur citations.

For example, the Official Action notes that the claims are rejected under 35 U.S.C. § 101,

“because there is no recitation indicating “the use of a computer method/system” and a mere implementation of employing processing in the preamble or method steps does not confer statutory subject matter.”<sup>1</sup>

It is unclear how this discussion relates to the Applicants' claims. It appears as though the Official Action is stating that method claims are somehow non-statutory unless they recite a computer method/system. Moreover, it is unclear how Applicants' preamble relates to the rejection of Claims 2-8, 10-13, 15, and 16 under 35 U.S.C. § 101.

Accordingly, Applicants respectfully request that the Examiner clarify his position in this respect for the purposes of facilitating the appeal process.

Next, the Official Action cites a portion of Claim 2 in support of the assertion that Claim 2 somehow suggests or makes optional limitations of method Claim 2.<sup>2</sup> Applicants note that the cited claim limitation, namely, “whether copying of the content is allowed or

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<sup>1</sup> Official Action at page 3.

<sup>2</sup> Official Action at paragraph bridging pages 3 and 4.

not” is not optional language, but simply recites that a decision requires an outcome, namely the allowance of copying, or, the prohibition of copying. Nevertheless, Applicants have amended Claims 2 and 3 to remove the claim term “or.”

Finally, the Official Action provides a dictionary definition for the term “database.”<sup>3</sup> It is unclear how this extrinsic evidence has any bearing on whether or not the rejected claims recite statutory subject matter. In this regard, the Examination Guidelines for Computer-Related Inventions states that,

Office personnel are to correlate each claim limitation to all portions of the disclosure that describe the claim limitation. This is to be done in all cases.<sup>4</sup>

Yet, the Official Action provides no discussion as to how the rejected claims lack a practical application in the technological arts, or, how one of skill in the art would understand this term, as well as others cited in the previous response, in the context of Applicants’ disclosures and claims. Simply stated, Applicants’ claims recite a method of utilizing time-based data of a database as compared to that of content provided to be duplicated for the purposes of allowing or prohibiting the duplication of content. **The prohibition of duplicating contents clearly provides a useful concrete and tangible results**, for example, in copy protection systems to preclude the copying of original content.

Accordingly, if this rejection is to be maintained, Applicants request an express statement on the record in the next communication as to how Applicants’ currently rejected Claims 2-8, 10-13, 15, and 16, as a whole, are directed to solely an abstract idea, or to manipulation of abstract ideas, or do not produce a useful result, in order to facilitate the appeal process.

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<sup>3</sup> Official Action at page 4.

<sup>4</sup> Examination Guidelines for Computer-Related Inventions at page 4.

REJECTION UNDER 35 U.S.C. § 112

The Official Action has rejected Claim 16 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicants respectfully traverse the rejection.

Applicants have amended Claim 16 to correspond to the preamble of Claim 3. Accordingly, Applicants respectfully request that the rejection of Claim 16 under 35 U.S.C. § 112 be withdrawn.

REJECTION UNDER 35 U.S.C. § 102

The Official Action has rejected Claims 2-8, 10-13, 15 and 16 under 35 U.S.C. § 102 as being anticipated by Sugiyama (U.S. Patent No. 5,933,625). The Official Action asserts that Sugiyama discloses all of the Applicants' claim limitations. Applicants respectfully traverse the rejection.

Amended Claim 2 recites, *inter alia*, an information processing method including:

... a storage step for storing information for discriminating contents duplicated in the past and temporal data as to a previous start time of duplication of said contents in the past into a database; ...  
wherein the duplication of the content is prohibited when an interval of time between the current time and the previous start time of duplication of said content in the past specified by the temporal data stored in the database is less than predetermined amount of time (emphasis added).

Sugiyama describes a system for authenticating communication between network devices. For example, as shown in Fig. 1 of Sugiyama, a unique time generating device, such as timer section (4), is provided within the CPU (1) of an electronic device. The electronic device includes a memory (2).<sup>5</sup> The memory includes a storage section (6) to store a total time value Tt, which is counted over a time measuring period, such as 100 years. The timer

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<sup>5</sup> Sugiyama at Fig. 1; Col. 9, lines 33-45.

section (4) of the CPU counts the total time value  $T_t$  constantly at a predetermined rate. The accumulating section (5) sequentially accumulates each unit of time value or “clock tick” indicated by the time section (4). In other words, the accumulating section (5) calculates an accumulated time  $T_m$ , so as to provide an elapsed time ( $T_t - T_m$ ).

As shown more specifically in Fig. 18, the unique time generating device enables an apparatus to authenticate an application program and visa versa. For example, as shown in the flow chart of Fig. 21 at installation, a unique time measurement is provided, encrypted and a time data  $T_x = (T_t - T_m)$  is produced. The time data  $T_x$  is then associated with a specific apparatus and specific application software. In this way, only when the two retrieved parameters (i.e., time data  $t_x$ ) match with each other is the specific computer installed with the correlated computer software.<sup>6</sup>

Conversely, in an exemplary embodiment of the Applicants’ invention as recited in amended Claim 2, an information processing apparatus and associated method are provided wherein the duplication of previously duplicated content is prohibited when an interval of time between a present time and the start time of the prior duplication of the content is less than a predetermined period. This feature enables the processing apparatus and associated method of the present invention to prevent mass duplication of already duplicated content.<sup>7</sup> Nowhere does Sugiyama disclose or suggest recording a previous duplication start time and comparing that time to a predetermined period for prohibiting duplication.

Simply stated, the claimed duplication start time and the prevention of the duplication of content in accordance with a predetermined interval of time, which is between a current time and a previously recorded start time, has no relation to the matching of an encrypted parameter for the purpose of authenticating an apparatus and/or program. Sugiyama provides

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<sup>6</sup> Sugiyama at Col. 20, lines 45-48.

<sup>7</sup> Application at page 70, lines 16-20

installation of software in the case where encrypted parameters match in an authentication exchange procedure. Sugiyama does not disclose or suggest comparing a previous duplication time of content to a pre-established interval for determining whether or not the content can be reproduced, as recited in Applicants' Claims 2 and 3 and any claim depending therefrom.

1. The Official Action does not provide a *prima facie* case of anticipation.

In response to the above arguments, which were previously provided in the response of May 17, 2005, the Official Action stated:

. . . Sugiyama discloses a comprehensive and dynamic time accumulating, generating, outputting, measuring means based on predetermined variables to facilitate authentication for accomplishing various tasks, including, unauthorized copying of information (column 2, lines 57-column 3, line 25). Sugiyama discloses that "time data tx is stored into the specific computer 26 and storage medium where the information is to be retained, during or after the making of the information by the computer 26. Thus, mutual authentication between the two is effected so as to determine a computer that is authorized to access the information storage medium" (column 22, lines 43-62)." As a consequence, when the information storage medium is attempted for unauthorized copying or utilization of the information, an error detection is made by comparison of the time data. Thus, effectively prevents unauthorized utilization of the target information. On the other hand, upon an authorization decision based on the time data, access and copying of the information is allowed...(emphasis added).<sup>8</sup>

Applicants note that the above paragraph does not discuss any portion of Sugiyama, which disclose or suggest **the duplication of the content is prohibited when an interval of time between the current time and the previous start time of duplication of said content specified by the temporal data stored in the database is less than predetermined amount of time, as presently recited in Applicants' amended Claim 2.** Conversely, the above passage seems to state that Sugiyama anticipates all inventions which utilize time-based information to prohibit copying.

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<sup>8</sup> Official Action at page 5.

Further, the Official Action stated that:

In fact, Sugiyama discloses that one of the aspects and benefits of the invention is to prevent abuse and unauthorized use of information based on various authentication parameters, especially, using time value and measurements in a dynamic fashion (column 20, lines 1-48, column 23, lines 20-43). Such principles can certainly be applied to prevent mass copying of information data based on predetermined time values, based on Sugiyama's unique time generation, accumulation, measurement, authentication and ultimate application (se Sugiyama's illustrations of embodiments 1-3) (emphasis added).<sup>9</sup>

It is unclear if the Official Action is asserting an obviousness-based rejection or how the above description relates to the Applicants' claim limitations, which recite **the duplication of the content is prohibited when an interval of time between the current time and the previous start time of duplication of said content specified by the temporal data stored in the database is less than predetermined amount of time.**

The Official Action further provides that:

Applicant further argues that Sugiyama "only allows the installation of software in the case where encrypted parameters match" and does not disclose or suggest comparing a previous time to pre-established interval for determining whether content can be reproduced (response p. 11). Sugiyama discloses, "The unique time generating device of the present invention may be incorporated in software installed in the computer used or stored in an IC (Integrated Circuit) chip provided in the computer. Specifically, the unique time generating device in the form of an IC chip may be run by a CPU coupled with a memory (column 10, lines 22-42)." . . . <sup>10</sup>

It is unclear how the above rationale relates to Applicants' claim limitations, which recite **the duplication of the content is prohibited when an interval of time between the current time and the previous start time of duplication of said content specified by the temporal data stored in the database is less than predetermined amount of time.**

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<sup>9</sup> Official Action at paragraph bridging pages 5 and 6.

<sup>10</sup> Official Action at page 6.

Additionally, after the above argument, the Official Action reproduces column 17, line 39 through column 18, line 16 of Sugiyama.<sup>11</sup> It is unclear how this passage relates to the Applicants' claim limitations as no discussion was provided, and the reproduced passage simply discloses the addition of further authentication data based on a subsequent time (TxE, TxH) of communication between a server and a requesting party computer. The reproduced passage does not disclose or suggest the duplication of the content is prohibited when an interval of time between the current time and the previous start time of duplication of said content specified by the temporal data stored in the database is less than predetermined amount of time.

Next, the Official Action states on page 7:

Moreover, in response to applicant's argument that the prior art does not disclose a processing feature that prevents mass duplication of already duplicated content, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963) (emphasis added).<sup>12</sup>

The above passage mischaracterizes Applicants' response. No such argument was made.

Accordingly, Applicants respectfully request that should the above rejection be maintained in a next communication, that the next communication provide a rebuttal of Applicants' arguments, based on the Applicants' claims, in order to facilitate the appeal process.

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<sup>11</sup> See Official Action at page 6.

<sup>12</sup> See Official Action at page 17.



REJECTION UNDER 35 U.S.C. § 103

The Official Action has rejected Claims 6-8 and 13 under 35 U.S.C. § 103 as being unpatentable over Sugiyama. The Official Action cites Sugiyama as disclosing all of the Applicants' claim limitations, with the exception of an express disclosure of the use of more specific discriminating criteria, such as the ISRC parameters. Likewise, the Official Action states that Sugiyama does not disclose a method of watermarking. In both of these regards, the Official Action states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to arrive at the Applicants' invention. Applicants respectfully traverse the rejection.

As previously outlined in the response filed May 17, 2005, the Official Action relies upon *In re Gulack* to support an obviousness rejection. As *In re Gulack* relates to descriptive material presented on a substrate for determining patentability, *In re Gulack* is wholly unrelated to the Applicants' claims. The nonfunctional descriptive written material distinguished in *In re Gulack* is only deemed nonfunctional as it relates to the patentability of a substrate. Simply stated, this case makes it clear that what is written on a substrate will not distinguish the invention from the prior art in terms of patentability of the substrate. It is unclear why the Official Action again recites this case as an ISRC parameter is not written material.

Applicants note that the Official Action has cited the above case in support of a proposition that the ISRC parameters of Claims 6-8 are somehow nonfunctional descriptive material. Of course, an ISRC identifier is a parameter discriminated within Applicants' system in accordance with its specific format and content in order to trigger a determination. The configuration to process this more specific parameter further limits the system of the base claim; this is in stark contrast to a mere font of typeface, as discussed in the cited case

law. The Official Action has repeatedly mischaracterized these cases as having anything to do with the configuration of an electronic system to process a specific type and format of a functional electronic parameter in accordance with the recitation of the Applicants' claims. Accordingly, Applicants submit that this rejection is deficient, and should be withdrawn, at least, for this reason alone.

As best understood by the Applicants, the Official Action also seems to take official notice that a comparison step in a method claim cannot be patently distinguished based upon parameters used in the comparison.<sup>13</sup> In other words, all parameters are obvious. Applicants are unaware of any such portion of the MPEP which supports such a proposition or any case law which supports the position of the Official Action.

Furthermore, to the extent that official notice is being taken, with regard to the above, it appears that the Official Action is taking official notice without providing a citation in support of its assertion.

If official notice is being taken, Applicants respectfully submit that official notice alone is not permissible as grounds for rejection in the outstanding Official Action. As stated in the MPEP at § 2144.03(A):

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21.

With regard to the above, Applicants respectfully submit that the features advantageously recited in Claims 6-8 and 13 are not "capable of instant and unquestionable demonstration as being well-known."

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<sup>13</sup> See Official Action at pages 7-8.

Accordingly, Applicants respectfully request that should the above rejection be maintained in a next communication, that the next communication provide a rebuttal of Applicants' arguments, based on the Applicants' claims, in order to facilitate the appeal process.

CONCLUSION

**Should the Examiner continue to disagree with the above distinctions, Applicants respectfully request that the Examiner provide an explanation via Advisory Action pursuant to MPEP § 714.13 specifically rebutting the points raised herein for purposes of facilitating the appeal process.**

**Please note in accordance with the discussion herein, should the rejections in the Official Action of August 10, 2005 be maintained, Applicants intend to request a Pre-Brief Appeal Conference in accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005.**

Consequently, in view of the foregoing amendment and remarks, it is respectfully submitted that the present Application, including Claims 2-8, 10-13, 15 and 16, is patently distinguished over the prior art, in condition for allowance, and such action is respectfully requested at an early date.


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